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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,840	09/13/2000	Paul Remijan	2476.1003-001	7821
30407	7590	02/01/2008		
BOWDITCH & DEWEY, LLP 311 MAIN STREET P.O. BOX 15156 WORCESTER, MA 01615-0156			EXAMINER LEUBECKER, JOHN P	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 02/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/660,840

Applicant(s)

REMIJAN ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 39-80 is/are pending in the application.
- 4a) Of the above claim(s) 19-21, 34, 40-50, 52-58 and 70-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 22-33, 35, 39, 51 and 59-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 25 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 12, recitation of a separate "illumination channel outer sheath" in addition to a "outer sheath" in claim 1 is indefinite since it appears that these are disclosed as being the same element, yet claimed as separate ones.

As to claim 25, recitation that the "fiber optic illumination channel" (now in claim 1) comprises a "fiber optic device" is indefinite since it is not clear how this claim further limits claim 1. In other words, reciting a "fiber optic illumination channel" in claim 1 implies use of fiber optics, making it unclear as to what "fiber optic device" in claim 25 is referring.

As to claim 67, term "lens assembly" (last line) lacks antecedent basis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 6, 9, 12, 15, 17, 18, 22-26, 28-31, 33, 35, 39, 51 and 59-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. (U.S. Pat. 5,423,312) in view of Allred, III (U.S. Pat. 4,854,302) and further in view of Kurtzer (U.S. Pat. 5,168,863) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 20070503.

As to the newly added limitations to claim 1, it is noted that the language directed to "a probe for orthopedic diagnostic imaging", wherein the "probe" comprises the previously claimed elements, does not impart additional structure but only implies an intended use. Specifying that the illumination channel is a "fiber optic illumination channel" has been previously addressed (note claim 25). The illumination channel was previously described as having an "outer sheath" (note previous claim 12, element 37). Note that the metallic, paint or resin layer (col.3, line 62 to col.4, line 8) formed with the light absorbing layer would form a "inner sheath". Thus, the illumination channel is "positioned between an inner sheath and an outer sheath".

Amendments to claims 28 and 51 are substantially similar and are addressed above. As to claim 65, sheath (37) is considered a "needle" due to its size and threaded connector (39) would anticipate a "locking mechanism".

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Allred III and Kurtzer, as described above, and further in view of Woodard et al. (U.S. Pat. 5,947,958) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 20070503.

6. Claims 7, 10, 13, 14, 16 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Allred III and Kurtzer for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 20070503.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Allred III and Kurtzer, as described above, and further in view of Eastman (U.S. Pat. 5,319,731) for the reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 20070503.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Allred III and Kurtzer, as described above, and further in view of Strack (U.S. Pat. 3,902,880) for the reasons set forth in numbered paragraph 9 of the previous Office Action, paper number 20070503.

9. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siegmund et al. in view of Allred III and Kurtzer, as described above, and further in view of Kishi et al. (U.S. Pat. 4,972,827) for the reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 20070503.

Response to Arguments

10. Applicant's arguments filed November 13 2007 have been fully considered but they are not persuasive.

Referring to the Siegmund reference, Applicant acknowledges that "there is no explicit description of the dimensions of the device described therein" and that "there is also no indication that the Siegmund device is anything but a device of conventional length and diameter". The Examiner agrees and this is the basis for the Examiner's rejections. As previously pointed out, Siegmund does not provide any specific dimension for the disclosed invention but instead suggests "interchangeable shafts of varying diameters or lengths" (col.4, lines 43-44). Chosen or required diameters or lengths depend in part on the intended use or environment, which, as purported by Siegmund, could be for viewing inside the body or inside industrial components (col.4, lines 13-16). Thus, the Examiner maintains the position that, without any specific limitation on size, it would be obvious to one of ordinary skill in the art to make the Siegmund device of any size suitable for the intended purpose, and particularly sizes that are already known in the prior art. And as shown by Allred III, the claimed size has been contemplated in the endoscope art.

Applicant's statement that "Siegmund expressly states at Col. 1, line 68 that his invention provides an endoscope "with comparable lengths and resolving capabilities" of the prior art" is slightly misleading since it is taken out of context. Although the Examiner wishes that Siegmund expressly makes such a statement (since it would further evidence the Examiner's position), Siegmund is actually comparing the cost of constructing the inventive endoscope with the cost of "prior art devices with comparable lengths and resolving capabilities" (note col.1, line 66 to col. 2, line 1). Thus it would follow that construction of an 8 cm endoscope according to Siegmund's disclosure would cost less than construction of an 8 cm endoscope in accordance with prior art methods. This does not in any way teach or suggest that the Siegmund device was

contemplated as only being of "conventional" size and that conventional size is greater than 10 cm.

Regarding Applicant's position that the Yoshida and Allred references are "specialized" devices in which there is no disposable component, the Examiner takes the position that such alleged facts have no relevance on how and for what they are being relied upon. In addition, Applicant's generalization the Siegmund reference as a "conventional system" (note page 14, last paragraph of Applicant's remarks) is not warranted due to the fact that no particular size is even implied.

Furthermore, Applicant's argument that there is no teaching in the references of using a cannula with a small diameter disposable device is questioned since at least tube (37) of Siegmund forms a cannula and this was pointed out in the previous rejection. It was also pointed out that the illumination channel was in the cannula (note Fig.1). Thus, the Examiner maintains the position that the combination of references does indeed show all the features of the claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/
Primary Examiner
Art Unit 3739

jpl